REMARKS

Claim 74 is rejected under 35 USC 103(a) as being unpatentable over Ranka et al, U.S. Patent No. 7,130,808 (misidentified as "U.S. Publication No. 2002/035568"), in view of Benthin et al, which is properly identified as U.S. Publication No. 2002/0035568. With respect, this rejection is traversed. Reconsideration is requested.

The *Graham* factors are applied below with respect to claim 74.

1. Scope and content of the prior art

A determination regarding alleged obviousness under 35 USC §103(a) begins with an analysis of the scope and content of the prior art.

Ranka'808 is not prior art. In particular, and pursuant to MPEP §706.02(l)(2), the undersigned represents as follows:

"Application Serial No. 10/017,074 and Application Serial No. 09/586,387, now U.S. Patent No. 7,130,808, were, at the time the invention of Application Serial No. 10/017,074 was made, commonly-owned (by Paramark, Inc.[1])."

Under 35 U.S.C. §103(c) and in view of the above statement, Ranka '808 should be disqualified (removed) as a reference.[2]

Benthin describes an apparatus that comprises a customer profile database containing profile information about customers, a customer profile manager providing current customer data concerning a customer receiving an automatic presentation, and a customer segmentation manager allowing customer profiles to be segmented based on campaigns, user actions, or both. A campaign editor accepts user input to define campaign definition data sets containing parameters for selecting customers according to the profile information about customers stored in the customer profile database and for defining associated product or service information. The apparatus also includes a customer dialog processor receiving a plurality of the campaign definition data sets and the current customer data; this processor outputs recommended

---

1 At the time the '808 patent issued, a third party owned both applications; the '808 patent is now owned by another third party.

2 The Examiner (in the Office action at page 3) also noted – correctly – that Ranka "does not explicitly teach a segmentation process." For at least this additional reason, claim 74 is not coextensive in scope with any claims in the Ranka '808 patent.

presentation parameters defining a presentation in accordance with a campaign associated with the plurality of campaign definition data sets. A customer information server is connected to a data store of automatic presentation information including product or service information and to a customer presentation interface device associated with the current customer. The customer information server receives the presentation parameters and provides a presentation by selecting information from the data store of automatic presentation information in accordance with the campaign. The customer profile database contains data on customer response, and the campaign editor comprises a customer behavior analysis module connected to the customer profile database for outputting data indicative of customer response to at least one of the plurality of campaigns. Preferably, the system further comprises a customer segmentation manager allowing customer profiles to be segmented based on campaigns, user actions, or both. Membership in a particular customer segment may be fixed (explicit) or dynamic (evolving).

2. Differences between the claims and the prior art

With respect, the Examiner's factual finding (at page 4), however, that Benthin "uses a greedy algorithm" to identify a segmentation that segments the target visitor population, is incorrect. Benthin itself does not mention a "greedy algorithm." Even if (as the Examiner contends) the Benthin technique operates to ensure "a certain standard of quality of presentation of information to customers in accordance with a particular campaign (at page 4), this conclusion does not imply any particular algorithm for use in accomplishing this goal – let alone the recited "greedy algorithm" (now recited in newly-added dependent claim 75).

"[E]very limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines." *In re Wilder*, 429 F.2d 447, 450 (CCPA 1970); *See also In re Wilson*, 424 F. 2d 1382, 1385 (CCPA 1970) ("[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.").

Rejections based on §103 must rest on a factual basis with these facts being interpreted *without hindsight reconstruction* of the invention from the prior art. The Examiner may not "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Warner*, 379 F.2d 10100, 1017 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Benthin does not disclose or suggest a "greedy algorithm."

3. Level of Skill

The cited art is representative of the level of ordinary skill in the art. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

4. There are no combined teachings

Where art is properly applied, a test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art, *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). Here, however, and because Ranka '808 is not prior art, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 74 and the alleged combined teachings in Ranka-Benthin. Thus, the rejection must be withdrawn.

Independent claim 74, even as amended, is patentable over Bethnin, and Ranka is not prior art.

Dependent claims 75-78 are patentable for at least the same reasons.

Reconsideration and favorable action are requested.

Respectfully submitted,

/David H. Judson/

By: _____

David H. Judson, Reg. No. 30,467

ATTORNEYS FOR APPLICANT

March 15, 2011